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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/033,224	10/26/2001	Ronald P. Sansone	F-399	8515

919 7590 12/15/2004

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EXAMINER

O'CONNOR, GERALD J

ART UNIT PAPER NUMBER

3627

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/033,224

Applicant(s)

Sansone M

Examiner

O'Connor

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on March 22, 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                    |                                                                             |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____.                                                |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4 and 5</u> .                                                             | 6) <input type="checkbox"/> Other: ____.                                    |

## **DETAILED ACTION**

### ***Preliminary Remarks***

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires that when new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claim previously presented (whether entered or not).

Misnumbered claims 25, 26, and 40-52 have been renumbered 3-17, respectively.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nicholls et al. (US 5,485,369), in view of Godin et al. (5,890,138).

Nicholls et al. clearly anticipate all the substantive elements of claims 1-17, except that, while Nicholls et al. do disclose scanning the UPC barcode of an article being picked in a warehouse for shipping, Nicholls et al. do not disclose using the scanned UPC barcode as a key value to look up the weight of the item in a database, thereby obviating the need for a scale to

weigh the item. Less significantly, Nicholls et al. disclose that their invention is applicable to any shipping system, but do not specifically disclose a retail kiosk shipping center embodiment, and do not specifically disclose that their network connection to the outside world is the Internet.

However, Godin et al. disclose a shipping method which indeed uses the UPC barcode value for an item to look up the weight of the item in a computer database in order to use that weight value as one of the necessary inputs to calculate shipping costs for the item, and the system of Godin et al. works over the Internet.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system and method of Nicholls et al. so as to determine the weight of an item to be shipped by using the UPC barcode to look up the weight of the item in a database rather than by measuring the weight with a scale, as well as to work over the Internet, all in accordance with the teachings of Godin et al., in order to eliminate the need to re-measure the weight of identical items each time one of those identical items was being shipped, and in order to work with any terminal in the world connected to the Internet, thereby saving time and effort.

Regarding the retail kiosk embodiment, such shipping centers are certainly well known in the art, hence, an obvious embodiment to be comprised by any generic improvement to shipping centers generally. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have further modified the shipping system and method of Nicholls et al. so as to comprise a retail kiosk embodiment, since so doing could be performed by any person of ordinary skill in the art with neither undue experimentation, nor risk of unexpected results.

***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to the disclosure.
5. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(703) 305-1525**, and whose facsimile number is **(703) 746-3976**.

The examiner can normally be reached weekdays from 9:30 to 6:00.

Inquiries of a general nature or simply relating to the status of the application should be directed to the receptionist, whose telephone number is (703) 308-1113.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Robert Olszewski, can be reached at (703) 308-5183.

Official replies to this Office action may be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies are preferred and should be directed to (703) 872-9306** (fax-back auto-reply receipt service provided). Mailed replies should be addressed to "Commissioner of Patents and Trademarks, Washington, DC 20231." Hand delivered replies should be left with the receptionist on the seventh floor of Crystal Park Five, 2451 Crystal Dr, Arlington, VA 22202.

GJOC

December 10, 2004

A handwritten signature in black ink, appearing to read "Gerald J. O'Connor", followed by the date "(12-10-04)" in parentheses.

Gerald J. O'Connor

Patent Examiner

Group Art Unit 3627